Intellectual Property Owners Association (IPO)

- Trade association representing companies and individuals in all fields of technology who own IP rights
- Members include >200 companies and >12,000 individuals
- Submitted written comments on Feb. 4, 2013
Reasons for filing RCEs

- To obtain consideration of IDS after final
  - Foreign references received after 1.97(e)(1) time
  - Art from non-counterpart foreign applications
  - Difficult to confirm 1/97(e)(2) statements for all people within Rule 56
Reasons for filing RCEs

- To amend claims/respond to new rejections after final
  - New rejections may be “caused by” previous amendments/IDS
Reasons for filing RCEs

- To amend claims or present new evidence to address a rejection, where previous arguments, amendments, and/or evidence was not successful.
  
  - May need more than one “round” of prosecution to fully understand rejections, resolve 112 issues
Reasons for filing RCEs

- To amend claims or present evidence to place application in better condition for appeal

- At the request of the Examiner, suggesting that an RCE will result in allowance (and earn extra counts)
IPO Concerns

- Growing backlog (over 90,000) of applications not examined since RCE filing
IPO Concerns

- Federal Register Notice: RCE backlog “diverts resources away from the examination of new applications”
  - IPO understands importance of reducing backlog of unexamined applications
  - But RCE examination is part of overall examination process
  - IPO urges focus on reducing overall pendency from filing to grant
IPO suggestions

- Develop and implement “best practices” for processing RCEs
  - Current RCE processing varies greatly among art units
  - Develop best practices to serve goals of compact prosecution and prompt grant of allowable claims
IPO suggestions

- Change docketing of RCEs to incentivize examiners to act promptly
  - Current docketing system puts RCEs as last priority
  - Post-RCE delays wastes PTO and applicant resources

Mid-stream, indefinite delay in prosecution
Examiner may forget invention, prior art, issues previously raised
Especially frustrating after an interview
IPO suggestions

- Change count system to at least not discourage examination of RCEs
  - Current count system *disincentivizes* examination of RCEs
  - Some examiners urge applicants to file CON applications because examiners get more credit
    - Forces applicants to bear additional costs (e.g., resubmitting claim amendments or evidence to bring CON up to date with pending application)
IPO suggestions

- Do not use fee structure to penalize RCEs
  - New fees are unduly high
    - Raise large entity RCE fee from $930 to $1,200 for first RCE and $1,700 for additional RCEs
  - New fees do not account for the fact that there are many legitimate reasons applicants file RCEs
  - Unfair to require applicants to pay such high fees when RCEs are not promptly examined
IPO suggestions

- Make After–Final Consideration Pilot permanent
  - IPO commends PTO’s creativity and efforts
  - Mixed experience: some examiners very willing to use, others refuse even minor, clerical amendments
  - Conduct widespread training of examiners to encourage use
IPO suggestions

- Provide additional:
  - *incentives* to encourage after final consideration of claim amendments, and
  - *guidance* on when claim amendments can be entered after final

  - To address new reference or ground of rejection

  - To address new explanation in final rejection
IPO suggestions

- Provide more information in advisory action relating to Examiner’s reaction to after-final claim amendments

- Eliminate MPEP 706.07(b) permitting examiner to make first action final after an RCE in many circumstances
Thank You.

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